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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/715,139 | 11/18/2003 | Nam-jeong Lee | 1293.1992 | 1910 |
| 21171 | 7590 | 10/03/2006 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | NILAND, PATRICK DENNIS | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1714 | |

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/715,139

Applicant(s)

LEE ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 34-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/05,1/04,11/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 16-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-19 and 29-41 of copending Application No. 10/689511 in view of US Pat. No. 6004735 Schell et al. and US Pat. No. 6790572 Tamoto et al.. The copending claims claim the instantly claimed organic photoreceptor except for the instantly claimed use of the fluorine resin in the overcoat layer. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed fluorine resin in the overcoating composition of the copending claims because the use of fluorine resins in combination with other overcoating binders, including polyurethanes, in organophotoreceptors is expected to give the lubricating properties described by Schell at column 4, lines 59-67 and column 5, lines 7-10 and 38-44 and the properties such fluorine resins give to the polyurethane/fluorine resin overcoating of Tamoto, the abstract; column 16, lines 56-40; and column 22, lines 31-32 and 44.

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This is a provisional obviousness-type double patenting rejection.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6790572 Tamoto et al. in combination with the teachings of US Pat. No. 6004735 Schell et al., and US Pat. No. 5863980 Choi et al..

Tamoto et al. discloses organophotoreceptors having the instantly claimed layers including the instantly claimed overcoating, i.e. "protective layer", which can contain polyurethane, fluorine resin, and an organic compound having an acid number of 10-700 at the abstract; column 1, lines 28-31, which shows the desire to limit pollution which is also required by the EPA and Federal Regulations; column 5, lines 12-62, which states that durability is required along with good dispersibility of the filler and reduction of residual potential; column 6, lines 13-36; column 7, lines 1-10; column 8, lines 25-67, particularly 52-61; column 9, lines 1-16; column 15, line 66; column 16, lines 52-67, particularly 39-40, which discloses the instantly claimed fluorine resins; column 17, lines 1-67; column 19, lines 46-51, which shows that the organic compound having carboxyl groups can be a polymer; column 20, lines 1-67, particularly 12-17, which shows that filler/binder affinity should be increased, and 61-67; column 21, lines 1-41, particularly 20-36; column 22, lines 13-44, particularly 44; and the remainder of the document. The polyurethane is not disclosed as being anionic nor aqueous.

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It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the topcoating of Tamoto et al. having an anionic containing polyurethane as the binder and the organic compound having carboxyl groups because this would reduce pollution, as desired by Tamoto et al., column 1, lines 28-31, and would give the benefits of the polyurethane resin disclosed by Tamoto, the carboxyl containing polymers disclosed by Tamoto, and the ordinary skilled artisan would recognize that using the same resin as both the binder and carboxyl containing compound of Tamoto would eliminate compatability problems between these two components while giving the exceptional properties of aqueous anionic urethanes, as described by Choi et al. throughout their entire patent, to the topcoating of Tamoto et al. as well as the fact that Schell et al. shows combinations of aqueous urethanes and fluorine resins to be known for coating image forming layers at column 4, line 59 to column 5, line 44, particularly lines 7-8 and 40-44.

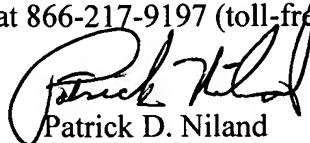
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Patrick D. Niland", is positioned above the printed name.

Patrick D. Niland
Primary Examiner
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